

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIM HUGUNIN

Appeal No. 2004-0541
Application No. 09/739,718

ON BRIEF



Before PAK, TIMM, and DELMENDO, *Administrative Patent Judges*.
PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 18, 20 through 24 and 26 through 32, which are all the claims pending in the above-identified application.

Claims 18 and 23 are representative of the subject matter on appeal and read as follows:

18. A fishing lure, comprising:

a spoonlike body portion;

at least one cavity formed in said body portion; and

a scent receiving element located in said at least one cavity, wherein said body portion defines a plane and said scent receiving element defines a plane, and said scent receiving element being embedded in said body portion such that said plane of said scent receiving element is coplanar with said plane of said body portion.

23. A fishing lure comprising:

a body portion having an end, said end defining a contour; and

a scent receiving element attached to and extending from said end of said body portion, said scent receiving element adapted to conform to the contour of said end of said body portion.

The prior art references relied upon by the examiner are:

Walker	4,962,609	Oct. 16, 1990
Mooers	6,061,947	May 16, 2000
		(Filed Jul. 21, 1999)
Monticello et al. (Monticello)	6,301,823 B1	Oct. 16, 2001
		(Filed Jun. 7, 2000)

Claims 18, 20, 21, 26 and 29 through 31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Mooers. Claims 18, 20, 21, 26 and 28 through 31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Monticello. Claims 23, 24, 27 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of

Walker. Claim 22 stands rejected under 35 U.S.C. § 103 as unpatentable over the disclosure of Mooers.

We reverse the aforementioned rejections and remand the application to the examiner for appropriate action consistent with the instruction below.

An anticipation under Section 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984).

Here, the examiner has not demonstrated that Mooers or Monticello inherently or expressly teaches a scent receiving element being embedded in the spoon-like body portion of a fishing lure such that the plane of the scent receiving element is "coplanar"¹ with the plane of the spoon-like body portion as required by claim 18.² See also the Brief, pages 6, 9 and 10.

¹ According to page 310 of Webster's II New Riverside University Dictionary (1994) attached to this decision, "coplanar" means "[l]ying or occurring in the same plane."

² It cannot be said that Mooers or Monticello expressly or inherently teaches the shape and size of the scent receiving

Nor has the examiner evinced that Moores teaches embedding the scent receiving element in a spoon-like body portion as required by claim 18. See also the Brief, page 6. Similarly, the examiner has not demonstrated that Walker expressly or inherently teaches placing a scent receiving material at the end of a body portion of a fishing lure such that the contour of the scent receiving material conforms to the contour of the end of the body portion as required by claim 23. See also the Brief, page 12.

Thus, on this record, we concur with the appellant that the examiner has not established a *prima facie* case of anticipation within the meaning of 35 U.S.C. § 102. Accordingly, we reverse the examiner's Section 102 rejections.

We also reverse the examiner's Section 103 rejection of claim 22 as unpatentable over the disclosure of Mooers. On this record, the examiner has not explained why one of ordinary skill in the art would have been led to arrive at the above missing features in Mooers. See the Answer in its entirety.

element which conforms exactly to the size and shape of the cavity of the spoon-like body portion so that, upon inserting, their every contour lies in the same plane. This "coplanar" requirement is to prevent the scent receiving element from interfering with "the performance of the lure." Compare the Answer in its entirety with the Brief, pages 6, 9 and 10, together with the specification, page 12.

As a final point, we note that Monticello teaches a fishing lure having an absorbent material 21 corresponding to the claimed scent receiving material embedded in a spoon-like body. See column 2, lines 31-40 and column 4, lines 42-46, together with Figure 1. Although Monticello is silent as to the contour of the scent receiving material relative to the contour of the spoon-like body (coplanar), it requires that the scent receiving material be **contained** in the spoon-like body. See column 4, lines 42-43. From our perspective, one of ordinary skill in the art embedding the scent receiving material into the spoon-like body would have been led to place the scent receiving material into the spoon-like body in such a manner that the surface of the body is continuous and does not interfere with the aerodynamic performance of a fishing lure. In other words, it would have been *prima facie* obvious to one of ordinary skill in the art to ensure that the plane of the embedded scent receiving element is either "coplanar" or substantially "coplanar" to the plane of the spoon-like body of a fishing lure. One of ordinary skill in the art would have been led to the claimed "coplanar" feature, motivated by a reasonable expectation of successfully maintaining the intended superior performance of an original fishing lure design. Thus, upon return of this application, the examiner is

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advised to reopen the prosecution of this application and determine which claims would have been **obvious** in light of the teachings of Monticello.

We also note that Mooers refers to U.S. Patent No. 5,595,015 issued to Jensen on Jan 21, 1997 which is said to teach placing a scented bait at the bottom end of the body of a fishing lure. Thus, the examiner is to review the content of Jensen and determine whether Jensen alone, or in combination with Walker, affects the patentability of the subject matter defined by claim 23 and its dependent claims.

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In view of the foregoing, we reverse the examiner's Section 102 and 103 rejections and remand the application to the examiner to take appropriate action not inconsistent with the above instruction.

REVERSED/REMANDED



CHUNG K. PAK)
Administrative Patent Judge)



CATHERINE TIMM)
Administrative Patent Judge)



ROMULO H. DELMENDO)
Administrative Patent Judge)

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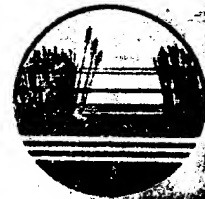
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